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|---|-------------|----------------------|---------------------|------------------|
| 09/604,525 | 06/27/2000 | Humberto C. Portillo | 10722-31970 | 4943 |
| 24728 7590 01/08/2009 MORRIS MANNING MARTIN LLP 3343 PEACHTREE ROAD, NE 1600 ATLANTA FINANCIAL CENTER ATLANTA, GA 30326 | | | | |
| EXAMINER | | | | |
| MILEF, ELDA G | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: HUMBERTO PORTILLO, STEFAN IANTA,
SCOTT HANSEN AND MARCUS CUDINA

Application No. 09/604,525
Technology Center 3600

Mailed: January 8, 2009

Before TOI JOHNSON *Review Paralegal*
JOHNSON, *Review Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on June 3, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF

Grounds of Rejection

A review of the file finds that the grounds of rejection of the claims as provided in the Appeal Brief filed July 16, 2007 under the heading “Grounds of rejection to be reviewed on appeal” is not consistent with the grounds of rejection of claims of record. The grounds of rejection of the claims as provided in the Appeal Brief must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified.

A review of the last Office action finds that the grounds of rejection were listed as follows:

1. Claims 16,18-26, 28-39, 41-42, 44-52, 54-65, 67-68, 70-76, 78-89, 91-92, 94-100, 102-113, 115-116, 118-123, 125-136, and 138, 140-158 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin (US 6,141,653), in view of Business Wire article (09889724 from Dialog file 148’).
2. Claims 27, 40, 53, 66, 77, 90, 101, 114, 124, 137,159 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Conklin and the Business Wire article sited, as set forth above, in view of Godwin (Travel Weekly, v44, pg 19(2), #02472750 from file 148).

However, Appellants have improperly listed the grounds of rejection as:

Claims 16, 18-42, 44-68, 70-92, 94-116, 118-138 and 140-159 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,141,653 issued to *Conklin et al* (hereinafter referenced as *Conklin*), in view of a *Business Wire* article (09889724 from Dialog file148)(hereinafter referenced as *Business Wire* article), and further in view of *Godwin* (Travel Weekly, v44, pg. 19(2), #02472750 from 148)(hereinafter referenced as *Godwin*). The issue on this appeal is whether claims 16, 18-42, 44-68, 70-92, 94-116, 118-138 and 140-159 are unpatentable under 35 U.S.C. § 103(a) as obvious over *Conklin* in view of *Business Wire Article*, and further in view of *Godwin*.

Correction of the Grounds of rejection to be reviewed on appeal for all claims is required.

Arguments

A review of the file finds that the arguments with respect to each grounds of rejection as provided in the Appeal Brief filed July 16, 2007 under the heading “Argument” has not been clearly provided. Each grounds of rejection must be treated under a separate heading in accordance with 37 CFR 41.37(c)(1)(vii). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

Appellant has not provided the necessary headings and/or subheadings for arguments which correspond to each grounds of rejection. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007) for details.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed July 16, 2007 defective;
- 2) notify Appellants to submit a Supplemental Appeal Brief which corrects the Grounds of Rejection to be Reviewed on Appeal and Arguments sections as noted above;
- 3) acknowledge and consider the Supplemental Appeal Brief submitted by Appellants in response to the Notice of Non-Compliance to correct the Appeal Brief as required by 37 § 41.37(c)(1)(vi)(vii); and
- 4) for such further action as may be appropriate

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

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